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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,094	05/31/2001	Kazumasa Sato	450100-03252	9307

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FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE- 10TH FL.
NEW YORK, NY 10151

EXAMINER

LU, KUEN S

ART UNIT PAPER NUMBER

2177

DATE MAILED: 11/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/871,094

Applicant(s)

SATO ET AL.

Examiner

Kuen S Lu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Abstract

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

The abstract of the disclosure is objected to because it contains phrase "or the like" which is not concise. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 14 and 15 are rejected under 35 U.S.C. 102(e) as anticipated by Hachiya et al. (U.S. Patent 6,199,097).

As per claims 1, 14 and 15, Hachiya et al. (hereafter Hachiya) teaches the following:

“an electronic mail download means for downloading an E-mail addressed to a user from a predetermined server” at col. 11, lines 16-18 by judging an e-mail arrived in the mail drop and receiving the e-mail from the mail server;

“a mail character string extract means for extracting a predetermined character string contained in said E-mail downloaded by said E-mail download means” at col. 2, lines 18-24 by receiving a plurality of e-mails, extracting a mail header and agent parameters from each received e-mails and collecting the agent parameters associated with a pre-set mail headers collected from the e-mails; and

“a control means for executing a predetermined processing correlated in advance to said predetermined character string extracted by said mail character string extract means” at col. 2, lines 37-44 by having a program adapted for performing control of receiving a plurality of e-mails, extracting a mail header and agent parameters from each received e-mails and collecting the agent parameters associated with a pre-set mail headers collected from the e-mails, and at col. 2 line 65 – col. 3, lines 4 by having the program installed and manifested on the collection apparatus associated operatively with the e-mail sending/receiving system.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under

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35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 2-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hachiya et al. (U.S. Patent 6,199,097) as applied to claims 1, 14 and 15 above, and in view of Uomini (U.S. Patent 6,018,761).

As per claim 2, Hachiya does not specifically teach extracting domain name in the mail address of a mail header.

However, Uomini teaches "means extracts, as said character string, a domain name included in a mail address of a mail sender in a mail header information contained in said E-mail" at col. 6, line 60 – col. 7, line 3 by examining message to determine if the sender's mail address is available and the domain is valid.

It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention was made to combine Uomini's reference with Hachiya's teaching by including domain name extraction as part of e-mail header extraction process because by doing so the e-mail sender's city and state data could be obtained from domain name resolution server through domain name record, for further utilization of e-mail or commercial activities.

As for claim 3, Uomini teaches "...control means, when executing said processing correlated with said domain name extracted as said character string, determines contents of said processing on the basis of a predetermined processing correlation table in which said domain name and said processing are correlated" at steps S13, S14 and S15, Fig. 4 and col.

6, line 66 – col. 7, line 3 by fetching city and state data of the e-mail sender through the correlation of domain name resolution server and domain name record.

As for claim 4, Uomini teaches “mail character string extract means extracts, as said character string, a mail account included in the mail address of the sender in the mail header information contained in said e-mail” at col. 6, lines 60-61 and 66-67 by examining e-mail message on sender’s address, and at Figs. 2(b) and 2(c) by showing account name of e-mail sender in the first line of the header data.

As for claims 5 and 10, Uomini teaches “control means, when executing said processing correlated with said mail account extracted as said character string, determines contents of said processing on the basis of the predetermined processing correlation table in which said mail account and said processing are correlated with each other” at col. 6, lines 60-61 and 66-67 by executing a process to examine sender’s address in the e-mail message, and at Figs. 2(b) and 2(c) by showing account name of e-mail sender in the first line of the header data.

As per claim 6, Uomini teaches “mail character string extract means extracts, as said character string, the domain name and the mail account included in the mail address of the sender contained in the mail header information in said e-mail” at at col. 6, lines 60-61 and 66-67 by examining e-mail message on sender’s address, and at Figs. 2(b) and 2(c) by showing account and domain names of e-mail sender in the first line of the header data.

As for claim 7, Uomini teaches “processing correlated with said domain name and said mail account extracted as said character string, determines contents of said

processing on the basis of a predetermined processing correlation table in which said domain name and said mail account are correlated with said processing” at col. 6, lines 60-61 and 66-67 by executing a process to examine sender’s address in the e-mail message, and at Figs. 2(b) and 2(c) by showing account and domain names of e-mail sender in the first line of the header data.

As for claim 8, Uomini teaches “the domain name and the- mail account in the mail address of the mail sender contained in the mail header information of said E-mail coincide with a preset domain name and a mail account which are registered in advance, extracts the preset character string contained in a text of said e-mail” at col. 6, lines 60-61 and 66-67 by examining sender’s address in the e-mail message, and at Figs. 2(b) and 2(c) by showing account and domain names of e-mail sender in the first line of the header data and elements 24, 26 and 28, Fig. 1, col. 3, lines 1-5 and col. 4, lines 23-34 by pre-storing e-mail sender context information in the repository.

As for claims 9 and 11, Uomini teaches “executing said processing correlated with said specific character string contained in the text of said E-mail, determines contents of said processing on the basis of a predetermined processing correlation table in which said specific character string and said processing are correlated with each other” at col. 6, lines 60-61 and 66-67 by executing a process to examine sender’s address in the e-mail message, and at Figs. 2(b) and 2(c) by showing account and domain names of e-mail sender in the first line of the header data and elements 24, 26 and 28, Fig. 1, col. 3, lines 1-5 and col. 4, lines 23-34 by pre-storing e-mail sender context information in the repository.

As for claims 12-13, Uomini teaches "control means enables to display a picture according to a picture data on a display as a result of said processing" and "control means enables to reproduce and output a music data as a result of said processing " at col. 2, lines 27-44 by including picture and other identifying information as a context for e-mail and at step 5, Fig. 3 and col. 6, line 13-15 by displaying context data.

Conclusion

The prior art made of record

- A. U.S. Patent No. 6199097
- B. U.S. Patent No. 6018761

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- C. U.S. Patent No. 5951636
- D. U.S. Pub. No. 2003/0120607
- E. U.S. Patent No. 6009462
- F. U.S. Pub. No. 2003/0135555

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kuen S Lu whose telephone number is 703-305-4894. The examiner can normally be reached on 8 AM to 5 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached on 703-305-9790. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

KL

Patent Examiner

October 30, 2003


JOHN BREENE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100